

REMARKS

Claim Amendments:

Claim 1 has been amended to recite that the alumina particles are applied to the coating and that a top layer is adhered to the alumina-silicate coating. Support for this amendment can be found in the specification at page 3, lines 11-13 and line 33 through page 4, line 3. Claim 2 has been amended to specify that the top layer comprises a catalyst. Support for this amendment may be found in original claim 2 and page 3, line 33 through page 4, line 3.

Election/Restriction:

Applicants note with appreciation the Examiner's indication that should product claims be found allowable, consideration will be given to rejoinder of the method claims.

Rejection of Claims 1-7, 9 and 10 Under 35 U.S.C. § 102(a)

Claims 1-7, 9 and 10 were rejected as allegedly being anticipated by WO 03/050397 and United States Patent No. 6,725,656, which are the PCT and United States counterparts of the same patent application. Applicants respectfully traverse this rejection.

Claim 1 recites a coated metal substrate comprising a metal substrate having an alumina-silicate coating adhered thereon, the alumina-silicate coating having alumina particles applied to the coating and a top layer adhered to the alumina-silicate coating. Applicants' specification demonstrates that coating compositions do not adhere well to the alumina-silicate coating, particularly under conditions to which the coated metal substrate will be exposed during operation of a small engine,

partly due to the fact that the surface of the alumina-silicate coating is quite smooth. (applicants' specification at page 3, lines 14-16). Example 1 demonstrates that when the alumina-silicate coating merely contains alumina particles, the top coating over the alumina-silicate coating does not adhere. On the other hand, Example 2 demonstrates that when the aluminum oxide particles are applied to the alumina-silicate coating, as opposed to being mixed in with the coating prior to application, the top coating adhered to the alumina-silicate coating.

WO 03/050397 fails to teach or suggest the invention defined by claim 1. WO 03/050397 teaches mixing fibers and non-fibrous filler material for the inner layer, and teaches that the "ceramic filler fills the void or interstitial space between the fibers, and preferably coats the fibers." See paragraph 29, lines 6-7. In addition, the ceramic filler material in the inner and insulation layers 22 and 24 preferably coats or binds the ceramic fibers present in that layer. See paragraph 0040, lines 4-6.

Thus, WO 03/050397 discloses mixing the ceramic filler material in both the insulation layer 24 and the inner layer 22 so that the ceramic filler material coats or binds the ceramic fibers present in the respective layers, teaching away from the presently claimed invention. Note that claim 1 of the instant application includes the limitation that the alumina particles are applied to the coating, and a top layer is adhered to the alumina-silicate coating.

The Examiner takes the position that the limitation "while the coating is still wet on the substrate" is a process limitation that is not given patentable weight. Applicants have eliminated the "while the coating is still wet on the substrate", however, applicants respectfully submit that the

limitation "applied to the coating" must be given patentable weight.

MPEP Section 2113 instructs that "[t]he structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garner*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.)" (emphasis added) In the instant case, applicants' specification amply demonstrates that when the alumina particles are mixed in with the alumina-silicate coating prior to application, the subsequently applied top layer does not bond to the alumina-silicate layer. However, when the alumina particles are applied to the alumina-silicate coating, the top layer adheres to the alumina-silicate coating, providing a catalyst that adheres over a wide range of conditions to which the coated metal substrate will be exposed during operation of a small engine. WO03/050397 fails to teach or suggest such a product having such distinctive structural characteristics.

Conclusion

Reconsideration of the above-referenced patent application in view of the foregoing amendment is respectfully requested. It is not believed that any fees are due upon submission of this

amendment. If any fees are due, however, the USPTO is authorized to charge Deposit Account No. 50-3329.

The undersigned was authorized by Richard A. Negin, Reg. No. 28,649, an attorney of record in the subject application, to prepare and file this Amendment on behalf of the Assignee. Correspondence should continue to be directed to Chief Patent Counsel, Engelhard Corporation, 101 Wood Avenue, P.O. Box 770, Iselin, NJ, 08830-0770.

Respectfully submitted,

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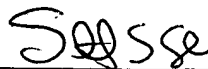
Date May 8, 2006

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CERTIFICATE UNDER 37 CFR 1.10: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail No. ED 467 143 789 US, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 8, 2006.



Signature: Scott S. Servilla